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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,916	02/25/2004	Philippe Vogt	DT-3161	2085

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EXAMINER

MAHONEY, CHRISTOPHER E

ART UNIT	PAPER NUMBER
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2851

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/786,916	Applicant(s) VOGT, PHILIPPE	
	Examiner Christopher E. Mahoney	Art Unit 2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Allowable Subject Matter

Claims 1-3 are allowed.

Claim Rejections - 35 USC § 251

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 251 that form the basis for the rejections under this section made in this Office action:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

If a claim is presented in a reissue application that omits, in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 U.S.C. 251.

Art Unit: 2851

If the claims are “broader than they are narrower in a manner directly pertinent to the subject matter... surrendered during prosecution” *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161, 1166 (Fed. Cir. 1997), then recapture will bar the claims.

The recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects (A) of the same scope as, or (B) broader in scope than, those claims canceled from the original application to obtain a patent. *In re Ball Corp. v. United States*, 729 F.2d at 1436, 221 USPQ at 295.

Claims 4-8 are rejected under 35 U.S.C. 251 as being recaptured subject matter. Specifically, the surrender generating limitation of “the blocking member has a first shoulder and a second shoulder, and the blocking pin is movably arranged in the lever” is missing from the currently rejected claims.

The following is from MPEP 1412.02:

(a) Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in Original Prosecution: In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. Element C was either a limitation added to AB to

obtain allowance of the original patent, or was argued by applicant to define over the art (or both). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related to the surrendered subject matter. Thus, the reissue claim, which no longer contains C, is broadened in an area related to the surrender, and the narrowing via the addition of D does not save the claim from recapture since D is not related to the surrendered subject matter.

In the example above as applied to applicant's claim 4, element C corresponds to the limitation of "the blocking member has a first shoulder and a second shoulder, and the blocking pin is movably arranged in the lever" and element D corresponds to "a head (12), a spring element (27) for biasing the head (12) against the second member (6)".

The applicant is directed to review MPEP 1412.01 and 1412.02. as well as *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001)

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E. Mahoney whose telephone number is (571) 272-2122. The examiner can normally be reached on 8:30AM-5PM, Monday-Thursday.

Art Unit: 2851

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diane Lee can be reached on (571) 272-2399. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher E Mahoney
Primary Examiner
Art Unit 2851